REMARKS/ARGUMENT

Claims 1, 10, 15, 24, 32, 40 and 48 have been amended. Claims 1-48 are pending in the Application. The application has been carefully reviewed in light of the Office Action mailed on December 22, 2003. Reconsideration of all outstanding rejections in light of the following remarks is respectfully requested.

Claims 1, 10, 15, 24, 32, 40 and 48 have been amended to correct antecedent and grammatical errors.

Claims 1-48 stand rejected under 35 U.S.C. § 103(a) as being rendered unpatentable over Christeson, *et al.* (U.S. Patent No. 6,122,733) (hereinafter "Christeson") in view of Windows Update and further in view of the Internet Protocol addressing system. Reconsideration is respectfully requested.

Claim 1 recites, *inter alia*, a "method of recovering a corrupt computer system BIOS comprising ... checking the validity of a ... BIOS ... if said BIOS is not valid: ... establish[ing] a communications connection with a recovery server ... connecting to said recovery server and sending system information to said recovery server ...."

The Office Action at page 3-4 admits that Christeson does not disclose, *inter alia*, "connecting to said *recovery server* and sending system information to said *recovery server* ..." as in claim 1. The Office Action then continues by stating that sending system information to an update server is notoriously well known in the art citing the Windows update feature. The Office Action then states that a person of ordinary skill in the art would have been motivated to send system information to an update server because it can identify components needed by the computer corresponding to the system information.

Applicant notes that the Office Action recognizes a difference between "connecting to a *recovery server* and sending system information to said *recovery server*", as in claim 1 and the sending of system information to an update server. According to the Office Action, the Windows update function connects to an "update server" and

downloads updated Windows features. The recovery server, as defined in claim 1, performs the function of "downloading an uncorrupted BIOS from said recovery server ...." The Windows update feature downloads a new Windows feature regardless of whether or not there is any corruption in an existing windows program, thus is a very different operation than the method described in claim 1 where a corrupted BIOS is first recognized and than a BIOS recovery using a remote server is initiated.

Moreover, the Windows update feature relies completely on a computer with a fully operative BIOS system. It could not be implemented on a system with a corrupted BIOS since the computer would not properly boot in the first place.

MPEP § 2143 sets forth the requirements to be shown by the Examiner in order to have successfully established a prima facie case of obviousness. To establish a case of prima facie obviousness: i) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, ii) there must be a reasonable expectation of success, and iii) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Moreover, MPEP § 2143.01 states that some *additional objective reason* to combine the teachings of references must be shown by the Examiner. That is, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art itself also suggests the desirability of the combination. MPEP § 2143.01 quoting In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990).

No such teaching, suggestion or motivation is present in the cited references or indefinitely described art (i.e., Windows update feature or IP address system). Without using the present claims as a roadmap, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references. The rejections are based on an impermissible hindsight reconstruction of the present invention from the cited references. *See* Ex parte Clapp, 227 U.S.P.Q. 972 (Bd.

App. 1985) (requiring "convincing line of reasoning" to support obviousness determination). The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. *See* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). *See e.g.* Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051 (Fed. Cir. 1988) (It is impermissible to reconstruct the claimed invention from selected prior art absent some suggestion, teaching or motivation in the prior art to do so). Accordingly, the outstanding rejections of claim 1 are not well founded, thus claim 1 is allowable. Claims 2-9 depend from claim 1, thus are also allowable along with claim 1 and for other reasons.

Independent claims 10, 15, 24, 32, 40 and 48 all stand rejected under 35 U.S.C. § 103(a) as being rendered obvious in view of Christeson in view of the Windows Update and IP address system. The Office Action rejections of claims 10, 15, 24, 32, 40 and 48, each of which are directed to fixing a corrupt BIOS, are all based upon the same arguments regarding the Windows update feature and the IP addressing system. For at least the same reasons as discussed above with respect to claim 1, the cited references do not teach or suggest a system, method or apparatus for recovering from a corrupt BIOS as recited in the claims. Accordingly, independent claims 10, 15, 24, 32 and 40 are allowable, as are all dependent claims.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: March 22, 2004

Respectfully submitted,

By_____

Thomas J. D'Amico
Registration No.: 28,371
Christopher A. Monsey
Registration No.: 53,242
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
2101 L Street NW
Washington, DC 20037-1526
(202) 785-9700
Attorney for Applicants